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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,197	11/12/2003	Philip L. Camillocci	132387IT/YOD GEMS:0230	5978
68174	7590	09/14/2010	EXAMINER	
GE HEALTHCARE c/o FLETCHER YODER, PC P.O. BOX 692289 HOUSTON, TX 77269-2289			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	
			MAIL DATE	DELIVERY MODE
			09/14/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP L. CAMILLOCCI and CRAIG E. STICKLES

Appeal 2009-009462
Application 10/706,197
Technology Center 3700

Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Philip L. Camillocci and Craig E. Stickles (Appellants) appeal under 35 U.S.C. § 134 (2002) from the Examiner's decision finally rejecting under 35 U.S.C. § 103(a) claims 1-4 and 7 as unpatentable over Kieffer (US 4,380,998, issued Apr. 26, 1983) and Yabe (US 5,514,074, issued May 7, 1996) (hereafter "Yabe '074"); claims 8-13, 15-29, and 31-40 over Kieffer and Yabe (US 5,458,133, issued Oct. 17, 1995) (hereafter "Yabe '133"); claim 5 over Kieffer, Yabe '074, and Yabe '133; and claims 14 and 30 over Kieffer, Yabe '133, and Moriyama (US 2002/0013510 A1, published Jan. 31, 2002). We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

THE INVENTION

Appellants' invention relates to a cover 34, 35 including a body having a recessed portion configured to releasably secure to an insertion portion of an endoscope. Spec. 3, ll. 14-15 and fig. 1.

Claim 1 is representative of the claimed invention and reads as follows:

1. A cover for use with an endoscope, comprising:
 - a body having a recessed portion configured to releasably secure to an insertion portion of the endoscope and;
 - a disinfecting compound disposed thereon, wherein the body is configured to be disposed on the tip of the endoscope only when the endoscope is not in use.

SUMMARY OF DECISION

We AFFIRM.

ANALYSIS

Appellants argue the rejection under 35 U.S.C. §103(a) of claims 1-4 and 7 together as a group. App. Br. 11. Therefore, in accordance with 37 C.F.R. 41.37(c)(1)(vii)(2009), we have selected claim 1 as the representative claim to decide the appeal, with claims 2-4 and 7 standing or falling with claim 1.

Claim 1 requires a “cover for use with an endoscope...only when the endoscope is not in use.” Appellants argue that “[i]n contrast, Kieffer discloses a device specifically designed to be used on an otoscope *when in use*.” App. Br. 8. According to Appellants, because endoscopes and otoscopes have different structures, “[t]he speculum taught by Kieffer... is incapable of performing as does the claimed endoscope cover.” Reply Br. 2. Furthermore, Appellants argue that “the subject matter disclosed by Kieffer is non-analogous art.” App. Br. 10. *See also* Reply Br. 3.

We find Appellants’ arguments unpersuasive for the following reasons. At the outset, we agree with the Examiner that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.” Ans. 8. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997). In this case, it is our finding that Kieffer discloses a removable speculum including a body 41 having a recessed portion for use in conjunction with an insertion end of an otoscope. Kieffer, col. 2, ll. 5-10 and fig. 2. *See also* Ans. 4. We agree with the Examiner that the speculum

41 of Kieffer “offers protection to the distal end of the endoscope, both during use and when not in use (i.e. transporting the instrument).” Ans. 8. “[A]pparatus claims cover what a device is, not what a device does.”

Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1468 (Fed. Cir. 1990). Therefore, as long as Kieffer’s speculum can be used when the otoscope is not in use then the claim limitation of a “cover for use with an endoscope...only when the endoscope is not in use” is satisfied.

Moreover, Appellants have not provided any evidence to show that Kieffer’s otoscope speculum cannot be used (*i.e.*, placed on the end of the otoscope) when the otoscope is not in use, *i.e.*, during transportation of the otoscope. An attorney’s arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). In conclusion, we find that the claimed purpose of Appellants’ cover, “for use with an endoscope...only when the endoscope is not in use” does not result in any structural difference between Appellants’ claimed cover and Kieffer’s otoscope speculum.

With respect to Appellants’ position that an endoscope and an otoscope “are inherently different both in their structure and functionality” (App. Br. 10), we find that an “otoscope is a particular and specialized class of device[s] generally known as endoscopes.” U.S. Patent No. 3,874,371, issued Apr. 1, 1975, col. 2, ll. 44-47. Therefore, we agree with the Examiner that “an otoscope is in fact an endoscope by definition and is analagous art.” Ans. 9.

Appellants further argue that each of Yabe ‘074, Yabe ‘133, and Moriyama does not disclose the limitation of a cover configured to be disposed on the tip of a probe end of an endoscope only when the endoscope

is not in use. App. Br. 11, 14, and 15. Reply Br. 4. We find Appellants' argument unpersuasive because as shown above Kieffer discloses such a cover. The disclosures of Yabe '074, Yabe '133, and Moriyama were used to show an antibacterial endoscope cover, an endoscope cover having an indicium, and an endoscope cover including an indicium having a raised surface, respectively. Ans. 4, 6, and 7. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

In conclusion, for the foregoing reasons, the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Kieffer and Yabe '074, and claims 2-4 and 7 standing or falling with claim 1, is sustained.

Regarding the rejections of claims 8-13, 15-29, and 31-40 over Kieffer and Yabe '133; claim 5 over Kieffer, Yabe '074, and Yabe '133; and claims 14 and 30 over Kieffer, Yabe '133, and Moriyama, Appellants do not present any arguments separate from the arguments presented with respect to claim 1. App. Br. 11-15. Accordingly, the rejections of claims 8-13, 15-29, and 31-40 over Kieffer and Yabe '133; claim 5 over Kieffer, Yabe '074, and Yabe '133; and claims 14 and 30 over Kieffer, Yabe '133, and Moriyama are likewise sustained.

SUMMARY

The decision of the Examiner to reject claims 1-5 and 7-40 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

mls

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